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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,966	11/14/2000	Scott D. Landes	5482	6125

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EXAMINER

COURSON, TANIA C

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/710,966

Applicant(s)

LANDES, SCOTT D.

Examiner

Tania C. Courson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being anticipated by Hanson (US 5,494,378).

Hanson discloses in Figures 1-9, an anchoring device comprising:

With respect to claim 1:

- a) a hollow elongated member (Fig. 1, hollow pipe 12) said elongated member having a first end (Fig. 1, upper end 13) and a second end (Fig. 1, lower end 15);
- b) a first integral anchoring flap (Fig. 1, cantilevered anchor fingers), said anchoring flap having a first end (Fig. 4) and a second end (Fig. 4, bendable tether necks), said anchoring flap located proximate the second end of said elongated member (Fig. 1);
- c) and a first flexible living hinge (Fig. 4, anchor tabs), said anchoring flap attached to the elongated member at the second end of said anchoring flap by said first flexible living hinge (Fig. 1), said anchoring flap moveable from a first closed position (Fig. 2) to facilitate handling and transportation of said marker post (column 4, lines 33-36) to a second open position (Fig. 6) to prevent withdrawal of said elongated member from an

embedded position (column 2, lines 17-20).

With respect to claim 2:

a) a second integral anchoring flap (Fig. 1, cantilevered anchor fingers), and a third integral anchoring flap (Fig. 1, cantilevered anchor fingers), said second integral anchoring flap and said third integral anchoring flap each having a first end and a second end (Fig. 1), said second integral anchoring flap and said third integral anchoring flap each located proximate the second end of said elongated member (Fig. 1), said first integral anchoring flap and said second integral anchoring flap and said third integral anchoring flap circumferentially positioned around the said elongated member (Fig. 3);

b) a second flexible living hinge and a third flexible living hinge (Fig. 1), said second integral anchoring flap attached to the elongated member at the second end of said second integral anchoring flap by the second flexible living hinge (Fig. 1), said third integral anchoring flap attached to the elongated member at the second end of said third integral anchoring flap by the third flexible living hinge (Fig. 1), said second integral anchoring flap and said third integral anchoring flap moveable from a first closed position (Fig. 2) to facilitate handling and transportation of said marker post (column 4, lines 33-36) to a second open position (Fig. 6) to prevent withdrawal of said elongated member from an embedded position (column 2, lines 17-20).

With respect to claim 4:

a) wherein said elongated member is triangular, circular, rectangular or square shaped

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(Figs. 3 and 9) and said elongated member includes a non-tapered exterior surface (Fig. 1, hollow pipe 12).

With respect to claims 5 and 11:

a) wherein said elongated member and said anchoring flap are weather resistant (Fig. 2) and said anchoring flap is in a coplanar condition with said marker post when said anchoring flap is in a closed position (Fig. 2).

With respect to claims 6 and 12:

a) including a weather resistant cap (Fig. 1, cap 16) for covering the first end of said elongated member (Fig. 1).

With respect to claims 7 and 10:

a) wherein said elongated member is sufficiently stiff to permit the marker post to be driven into a top layer of soil (Fig. 2);

With respect to claim 8:

a) an elongated member (Fig. 1) having a first panel, a second panel, and a third panel forming the elongated member (Fig. 1);
b) said elongated member having a first open end and a second open end (Fig. 1);
c) a first anchoring flap, a second anchoring flap, and a third anchoring flap (Fig. 1, cantilevered anchor fingers), each of said anchoring flaps having a first end and a second

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end (Fig. 4), each of said anchoring flaps integrally connected to said elongated member (Fig. 2), each of said anchoring flaps located proximate a second end of said elongated member (Fig. 1);

d) a first flexible living hinge, a second flexible living hinge, and a third flexible living hinge (Fig. 1), the second end of said first anchoring flap attached to the first panel of said elongated member by said first flexible living hinge, the second end of said second anchoring flap attached to the second panel of said elongated member by said second flexible living hinge (Fig. 1), the second end of said third anchoring flap attached to the third panel of said elongated member by said third flexible living hinge (Fig. 1), each of said anchoring flaps moveable from a first closed position (Fig. 2) to facilitate the handling and transportation of said marker post (column 4, lines 33-36) to a second open position (Fig. 6) to prevent the withdrawal of said elongate member from an embedded position (column 2, lines 17-20).

Hanson does not disclose said elongated member composed of a flexibly resilient polymer plastic, wherein said polymer plastic is polycarbonate or polyethylene and a triangular shaped elongate member.

Regarding claims 1, 3, 8 and 9: Hanson discloses the elongate member (hollow pipe 12) made of metallic (column 3, lines 25-26) materials. The particular type of material used to make the elongate member, absent any criticality, is only considered to be the use of a "preferred" or "optimum" material out of a plurality of well known materials that a person having ordinary skill

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in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

With respect to claim 8: the shape of the elongate member, i.e., triangular shaped, absent any criticality, are only considered to be obvious modifications of the shape of the elongate member (hollow pipe 12) disclosed by Hanson as the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the triangular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention. See In re Dailey, 149 USPQ 47 (CCPA 1976).

With respect to claim 8: It has been held that the functional "whereby" statement does not define any structure and accordingly can not serve to distinguish. In re Mason, 114 USPQ 127, 44 CCPA 937 (1957).

Response to Arguments

3. Applicant's arguments filed on January 22, 2003, have been fully considered but they are not persuasive.

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4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., above ground marker, elastic limit of applicant's material, upward forces) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

5. The examiner has taken the applicant's definition of "living hinge" to mean "anchoring flaps are movable from a first closed position" to "a second open position" and that "the flaps are integrally connected to the marker post", as stated on page 3, lines 4-9, of the applicant's specification. The claim language does not further specify the elastic limitation of the material.

6. In response to applicant's argument, regarding claims 1 and 8, that the Hanson reference does not teach "to facilitate handling and transportation of said marker post" and "to prevent withdrawal of said elongated member from an embedded position", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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7. In response to applicant's argument, regarding claim 4, that the Hanson reference does not teach "a non-tapered exterior surface", the examiner points out that Fig. 1 of the Hanson reference clearly shows "a non-tapered exterior" comparable to the "non-tapered exterior" as is shown in the Applicant's Fig. 1.

8. In response to applicant's argument, regarding claims 6 and 12, that the Hanson reference does not teach "a weather resistant cap for covering the first end to prevent rain or snow from entering the elongated member", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (703) 305-3031. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (703) 308-3875. The fax number for this Organization where this application or proceeding is assigned is (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DIEGO F.F. GUTIERREZ
SUPERVISORY PATENT EXAMINER
GROUP ART UNIT 2859

TCC
March 25, 2003